

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mitsuhiko Ono

Application No.: 09/873,649

Art Unit: N/A

Filed: June 4, 2001

Examiner: Not Yet Assigned

For: INTERGRATED CIRCUIT FOR MODEM

DECLARATION OF STEVEN I. WEISBURD

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

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APR 16 2004

Technology Center 2100

Dear Sir:

I, Steven I. Weisburd, declare as follows:

1. I am currently a partner in the law firm Dickstein Shapiro Morin & Oshinsky, LLP ("Dickstein"). I was formerly a partner at the law firm of Ostrolenk Faber Gerb & Soffen ("Ostrolenk").
2. I am registered to practice before the United States Patent and Trademark Office (USPTO) (Reg. No. 27,409).
3. I represent Mitsuhiko Ono, the inventor, in connection with prosecution of the above-captioned patent application before the USPTO.

4. Neither I nor anyone else at Dickstein received an Ex Parte Quayle Action, mailed September 23, 2003. In her April 8, 2004 Declaration (submitted herewith), Dickstein docketing specialist Henrietta Marron, whose responsibility it was to open, record, and docket mail received from the USPTO, stated that, as of March 30, 2004, no substantive paper was received from the USPTO for the above-captioned patent application. Subsequently, the only paper received was a Notice of Abandonment, mailed on March 31, 2004, addressed to Ostrolenk.

5. A search of the file jacket for the above-captioned patent application indicates that the Ex Parte Quayle Action was not received. Specifically, a search of the file jacket did not result in the location or discovery of the Ex Parte Quayle Action mailed September 24, 2003. Further, this search of the file jacket revealed a Notice of Recordation of Assignment document properly addressed to me at Dickstein. (Attached as Exhibit A.) Additionally, two Status Inquiries were submitted to the Patent Office, a first dated August 20, 2003, and a second dated February 19, 2004, both showing Dickstein as the mailing address. (Attached as Exhibit B).

6. If anyone employed by Dickstein had received the Ex Parte Quayle Action mailed March 23, 2003, that Ex Parte Quayle Action would have been entered into Dickstein's docket records. Specifically, a response to the Ex Parte Quayle Action would have been docketed for October 23, 2003 and a six month deadline would have been docketed for March 23, 2004.

7. A copy of Dickstein's docket records for October 23, 2003, and March 23, 2004 (labeled "October 2003" and "March 2004") are attached hereto as Exhibit C.

8. Dickstein's docket records (Exhibit C) have been redacted to protect client confidentiality. For all records, the redacted portions are the client names.

9. In all cases, sufficient information has been left un-redacted to distinguish the above-captioned patent application from the patent applications with due dates docketed for October 23, 2003 and March 23, 2004.

10. No redacted docket number corresponds to the docket number of the above-captioned patent application (A3156.0022).

11. The fact that no redacted docket number on Dickstein's docket records corresponds to the docket number of the above-captioned patent application indicates that the law firm did not receive the Ex Parte Quayle Action.

12. In his April 8, 2004 Declaration (submitted herewith), Dickstein's Formalities clerk David Andres, whose responsibilities included retrieving mail from Ostrolenk and delivering it to the Dickstein Docketing department stated that, part of his duties included going to Ostrolenk and retrieving mail.

13. Mr. Andres further asserts that were any mail delivered to Ostrolenk for me, he would bring such mail over and present it to Dickstein's docketing department to be docketed. Because no entry corresponding to the

above-captioned patent application appears on the docket, no mail was delivered either to Dickstein or Ostrolenk for this matter.

14. The fact that no docket number on Dickstein's docket records corresponds to the docket number of the above-captioned patent application indicates that Mr. Andres did not retrieve mail sent to Ostrolenk, including the Ex Parte Quayle Action.

15. When I joined Dickstein, I did not file a Notice with the United States Postal Office to have my mail forwarded from Ostrolenk to Dickstein.

16. As discussed above, the arrangement I have with Ostrolenk is to have a Dickstein employee go to Ostrolenk to pick up any mail delivered to Ostrolenk for me and hand carry such mail to Dickstein. As Ostrolenk is still an active law firm, no mail is "returned to sender" when addressed to me there.

17. Once the mail was hand carried to Dickstein, it would be brought to docketing for entry in the Dickstein docketing system.

18. A copy of the Notice of Abandonment delivered to Ostrolenk and brought to Dickstein and docketed using this procedure is attached as Exhibit D.

19. The fact that the Ex Parte Quayle Action does not appear in the Dickstein docket indicates that it was never received by either Ostrolenk or Dickstein.

Application No.: 09/873,649

Docket No.: A3156.0022

I am aware that willful false statements and the like are punishable by fine or imprisonment, or both under 18 U.S.C. § 1001 and may jeopardize the validity of the instant application or any patent issuing thereon. I certify that all statements made of my own knowledge are true and all statements made on information and belief are believed to be true.

Dated: April 8, 2004

Respectfully submitted,



Steven I. Weisburd